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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,231

Applicant(s)

LUDWIG ET AL.

Examiner

Yogesh C Garg

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 2,5-7,12,15,18,22,24-26 and 28-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,8-11,13,14,16,17,19-21,23 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 3-34, drawn to a method of electronic bill presentment and payment system comprising a biller system, a payor system, a database including global information relating to said biller and payor systems and using said global information, class 705, subclass 40.
 - II. Claim 2, drawn to a method of electronic bill presentment and payment system comprising a biller system, a payor system, a database including global information relating to said biller and payor systems and using business objects for modifying said global information, class 705, subclass 40.
2. Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as modifying said global information in the database and invention I does not require this. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have recognized divergent subject matter and for the reasons that search required for Invention II is not required for Invention I, restriction for examination purposes as indicated is proper.
4. **SPECIES**

This application contains claims directed to the following patentably distinct species of the claimed invention.

In the event applicant elects Invention I above, he is further obligated to elect among the following species as follows:

species 1 of claims 3-4,8-11,13-14,16-17,19,20-21, 23 and 27.

species 2 of claims 5, 15 and 18.

species 3 of claims 6.

species 4 of claims 4,7,and 24-26.

species 5 of claims 5 and 12.

species 6 of claims 6 and 22.

species 7 of claims 7 and 28-29.

species 8 of claims 8 and 30-31.

species 9 of claims 9 and 32-34.

5. During a telephone conversation with attorney Mr. Kevin Drucker on August 17, 2004 a provisional election was made without traverse to prosecute the invention of Group I and Species 1, claims 1, 3-4,8-11,13-14,16-17,19,20-21, 23 and 27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2, 5-7,12, 15, 18, 22, 24-26 and 28-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species

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to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-4, 8-11, 13-14, 16-17, 19-21, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (US Patent 6,173,272 B1), hereinafter, referred to as Thomas and further in view of Bowman-Amuah (US Patent 6,640,244)..

9.1. Regarding claims 1, 3-4, 13-14, 16-17, 19-21, and 27, Thomas teaches the following claimed limitations:

An electronic bill presentment and payment system comprising: at least one biller system and at least one payor system in communication with a payment processing system; said payment processing system comprising a database including global information relating to said biller system and said payor system and an application server;

said payment processing system is operable to receive invoice data from said biller system and store said invoice data on said database;

said payment processing system is capable of connection to a network, and wherein said biller system and said payor system comprise hardware and software for connecting to said payment processing system via said network;

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said network is selected from the group consisting of: local area network, wide area network, internet, intranet, extranet, a TCP/IP-based network, a wireless network, an e-mail based network of e-mail transmitters and receivers, a modem-based telephonic network, and an interactive telephonic network accessible to users by telephone;

said payment processing system is further operable to perform an action via said network selected from the group consisting of: transmitting to said payor system said invoice data, adjudicating said invoice data, allowing said payor system to pay said biller system, and one or more of the foregoing actions in combination;

said payment processing system further comprises computer-readable memory adapted for receiving and storing data and commands from said biller system and said payor system via said network;

said payment processing system further comprises a security mechanism for restricting unauthorized access;

said security mechanism is selected from the group consisting of: a digital signature, a PIN number, a password, a master key, and one or more of the foregoing in combination.

said invoice data comprises at least one payor system, at least one invoice stream, and at least one biller system identifier.

(For all the above limitations see at least col.3, lines 63-col.7, line 11 and col.24, lines 1-56).

Thomas does not disclose the following claimed limitation:
at least one modular business object containing specified instructions to govern financial transactions between said biller system and said payor system based on said global information, wherein said application server permits replacement of said business object with another modular business object containing other specified instructions using the same said global information and said payment processing system is further operable to permit said payor system and/or said biller system to select one said business object for execution and to execute said business object and said business object is selected from the group consisting of: an object for reviewing invoices, an object for making adjustments to invoices, and an object for initiating invoice payment.

However, in the same field of endeavor, that is use of modular business objects in implementing transactions, such as billing, payment, etc. via communication network, Bowman Amuah discloses the above claimed limitation, see at least some of the following segments:

col.10, line 43-col.12, line 47, " A preferred embodiment is written using JAVA, C, and the C++ language and utilizes object oriented programming methodology. **A need exists for these principles of OOP to be applied to a messaging interface of an electronic messaging system such that a set of OOP classes and objects for the messaging interface can be provided.....**",

col.172, line 33-col.175, line 67, “.. *The solutions one builds must be more: Flexible. Making it possible to replace or modify application components with minimal impact to the other components in the system. Scalable. Allowing you to reuse the functionality within existing systems by wrapping them as components within the new application. Adaptable.*”.

Figs 158-166, col.278, line 15-col.283, line 62, “ *A data retrieval mechanism is provided in operation 15802 for retrieving data from a database. For example, accepting bill payment over the phone might use the account number, customer name, amount due, date due, and credit card number. With this architecture, the example billing function retrieves account, customer, monthly bill, and bill payment objects. FIG. 165 illustrates the manner in which the present invention retrieves whole objects 16500. For reuse, business objects should be able to request and update themselves independently of each other*”.

col.298, lines 8-54, “..... *A group of business objects necessary for a transaction are provided and managed in a logical unit of work in operations 18202 and 18204..... Consider an Account Payment window, which displays information about an Account, Customer, Monthly Bill, and Payment. This window occasionally needs to send generic, technical messages to all business objects within its LUW.* “,

col.306, lines 5-col.307, line 3, “ *Consider a telecommunications system, with two separate business LUWs for paying bills and adding new services, like call waiting. An end user might launch windows for these two LUWs simultaneously. This would allow the user to multi-task while conversing with the customer. Both windows display Account and Customer information.... “.*

Note: LUW's are logical work units which include a group of objects to complete a transaction in paying bills, reviewing invoices, making adjustments to invoices, and initiating invoice payment.

In view of Bowman Amuah, it would have been obvious to one of an ordinary skill in the art to have modified Thomas to incorporate the feature of at least one modular business object containing specified instructions to govern financial transactions between said biller system and

said payor system based on said global information, wherein said application server permits replacement of said business object with another modular business object containing other specified instructions using the same said global information because the use of Object oriented programming/modules would benefit in simplifying the application programs, creating new capabilities without having to start from scratch, reusable class libraries and more (as explicitly suggested in Bowman Amuah, see at least col. 12, line 48-col.13, line 41).

9.2. Regarding claims 8-11, Thomas in view of Bowman-Amuah as applied to claim 1 teaches comprising a database to receive messages from a selected business object for retrieving data. Bowman-Amuah as applied to claim 1 does not disclose that database can interact with messages in XML format, and use of SQL in querying the database. However, Bowman-Amuah teaches this limitation (see at least col.40, line 66-col.41, line 46 for XML formatted messages and col.48, line 55-col.56, line 18 for SQL formatted interfacing with database). In view of Bowman-Amuah, it would have been obvious to one of an ordinary skill in the art to have modified Thomas in view of Bowman Amuah as applied to claim 1 to incorporate the feature of receiving messages in an extensible markup language format because it improves the document structure, when compared to HTML and makes it possible to more effectively index and search for information in databases and on the web (See Bowman-Amuah, col.41, lines 16-21) and also to incorporate the feature of using SQL format in interfacing with database because it is a well-known medium to interact and query the database, allowing clients to filter and summarize large amounts of data with very few lines of SQL code .

9.3. Regarding claim 23, Thomas in view of Bowman-Amuah as applied to claim 1 teaches an electronic bill presentment and payment v system comprising a database, as analyzed above

but does not suggest further comprising a backup mechanism adapted to store a mirror copy of said data stored on said database and permitting access to said mirror copy of said data in the event said original data is corrupt or unavailable. However, Bowman Amuah, in the same field of endeavor, discloses comprising a backup mechanism adapted to store a mirror copy of said data stored on said database and permitting access to said mirror copy of said data in the event said original data is corrupt or unavailable (see at least col.75, lines 26-28, "*Administration and systems management features such as remote management, remote configuration, **backup and recovery, and disaster recovery should be considered.***"). In view of Bowman-Amuah, it would have been obvious to one of an ordinary skill in the art to have modified Thomas in view of Bowman-Amuah as applied to claim 1 to incorporate the feature of comprising a backup mechanism adapted to store a mirror copy of said data stored on said database and permitting access to said mirror copy of said data in the event said original data is corrupt or unavailable because it is a well-known fact to backup and save mirror copies of important data so that in the event of a catastrophic computer failure the users could fall back upon the back up disks to use and retrieve data from backup records.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

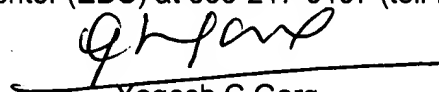
(i) Lamm, (US Patent 6,078,907), see at least col.4, lines 6-59 and Jones (US Publication No: 2002/0082990), see at least abstract and Fig.1 discloses a bill presentation system comprising a biller system, payer system and a database.

(ii) WO 00/46725 to Burns et al. (see at least abstract), WO 98/58339 to Murphy (see at least abstract), and WO 99/28843 to Crooks et al. (see at least abstract) teach computerized bill payment methods and systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
August 23, 2004